

### **REMARKS**

The foregoing Amendment and the following Remarks are submitted in response to the Office Action issued on May 4, 2006 in connection with the above-identified application, and are being filed within the three-month shortened statutory period set for responding to the Office Action. Applicants respectfully request reconsideration and withdrawal of the rejection of the claims, consistent with the following remarks.

Claims 1, 3, 4, 9, 11, 13, 14, and 19 remain pending in the present application. Claims 1 and 11 have been amended to more particularly point out and distinctly claim the subject matter that Applicants regard as the invention by including the subject matter of claims 10 and 20, respectively, as well as additional subject matter. Accordingly, claims 10 and 20 have been canceled. Applicants respectfully submit that no new matter has been added to the application by the Amendment.

Preliminarily, the Examiner states that, in connection with the response to the prior Office Action, the supposed failure to traverse the taking of Official Notice in such prior Office Action that a weighted body can be constructed from steel, as is recited in claims 9 and 19, constitutes an admission that such subject matter is prior art. Applicants respectfully disagree.

In particular, Applicants respectfully point out that the prior Office Action, issued on October 6, 2005, in fact contained no such Official Notice in connection with such claims 9 and 19 or in connection with any other claims. Instead, such claims 9 and 19 were rejected as being obvious over the cited McCrorey reference. Moreover, even if such an Official Notice existed in connection with the subject matter of such claims 9 and 19, Applicants respectfully note that the rejection of such claims 9 and 19 was specifically

traversed in the response to such prior Office Action, and respectfully submit that such traversal includes a traversal of any assertions made in connection with such rejected claims, including an assertion of Official Notice. Thus, Applicants respectfully submit that the Examiner is incorrect in asserting that a weighted body being constructed from steel, as is recited in claims 9 and 19, has been admitted as prior art. In fact, Applicants explicitly make no such admission, and no such admission can be implied.

The Examiner has rejected claims 1 and 11 under 35 USC § 102(b) as being anticipated by McCrorey (U.S. Patent No. 2,548,842). Applicants respectfully traverse the section 102(b) McCrorey rejection.

Independent claim 1 as amended to include the subject matter of now-canceled claim 10 and also to include additional subject matter recites a wheel-balancing weight for mounting to a wheel with a flange. The weight includes a weighted body and a clip securely attached thereto. The clip has a gripping section and the body has a gripping surface generally opposite the gripping section of the clip. The gripping section of the clip and the gripping surface of the body in combination define a compartment therebetween, where the compartment receives the flange therein when the weight is mounted thereto such that the gripping section of the clip and the gripping surface of the body are on opposite sides of the flange and grip the flange therebetween.

In pertinent part, claim 1 further recites that the clip has a generally planar attaching section by which the clip is attached to the body at a generally planar attaching surface thereof, and the clip at the generally planar attaching section thereof is attached to the body in a fixed manner by each attaching member such that the clip is substantially

immovable with respect to the body at each attaching member. In addition, the clip is formed as a single piece of material to include both the gripping section and the attaching section.

The flange has a generally axially extending lip extending from a generally radially extending brim, where the lip and brim in combination defining a pocket. The body has a flange face for facing toward the flange, where the flange face includes the gripping surface facing toward the lip of the flange and a generally planar brim surface for facing toward the brim of the flange. Moreover, the body has the generally planar attaching surface and the gripping surface of the flange face extends generally perpendicularly from the attaching surface and curves toward and joins the brim surface of the flange face. Significantly, the generally planar brim surface of the flange face is generally opposite to and generally parallel with the generally planar attaching surface.

The gripping section of the clip extends generally perpendicularly from the generally planar attaching section and curves along with but separable from the gripping surface of the flange face of the body. The generally planar attaching section of the clip is generally parallel to the generally planar attaching surface, and also the generally planar brim surface of the body. Notably, the gripping section of the clip has a distal edge that resides in a plane generally coextensive with the generally planar brim surface of the body.

Claim 11 recites substantially the same subject matter as claim 1, albeit in the form of a vehicle with the wheel and the weight of claim 1.

Thus, to summarize, the present invention includes:

- a planar attaching section of a clip, a generally planar attaching surface of a body, and a generally planar brim surface of a body that are all substantially parallel, and

- a gripping section of a clip that has a distal edge that resides in a plane generally coextensive with the generally planar brim surface of the body

among other distinctive features.

The McCrorey reference discloses a wheel-balancing weight with a body 1 and a clip formed from a latch 2 hingedly attached to a plate 6, where the body 1 and the clip in combination grip a mounted-to flange. Inasmuch as the clip recited in claims 1 and 11 is formed as a single piece of material to include both a gripping section and an attaching section, and is fixedly attached to the body, the Examiner has taken pains to show that such a clip may be found within the McCrorey reference as the plate 6.

That said, Applicants respectfully submit that such plate 6 does not include all of the features recited in claims 1 and 11. In particular, and as the Examiner notes, such plate 6 includes fingers 7, 8 that extend a limited distance to perform a rudimentary gripping function. However, and significantly, the McCrorey weight does not have a planar attaching section of a clip, a generally planar attaching surface of a body, and a generally planar brim surface of a body that are all substantially parallel, as is required by claims 1 and 11. Instead, and as best seen in Fig. 4 of the McCrorey reference, the McCrorey body 1 has a brim surface opposite a brim section B of the flange, where the brim surface that is markedly out of parallel with respect to the attaching section of the plate 6 (i.e., in the area of aperture 12 thereof) and the corresponding attaching surface of the body 1.

Moreover, based on such brim surface opposite brim section B as shown in the McCrorey reference, the gripping section of the plate 6 does not have a distal edge at the end of the fingers 7,8 that resides in a plane generally coextensive with the generally planar brim

surface of the body opposite such brim section B, as is required by claims 1 and 11. Instead, and as was previously pointed out, the McCrorey latch 2 has such a distal end and not such McCrorey plate 6, as is best seen in Fig. 4 of the McCrorey reference. In particular, and as disclosed at column 4, lines 5-10 of the McCrorey reference, the latch 2 upon being rotated against the plate 6 into position is stressed sufficiently to form with the body 1 an effective spring clamp, where the distal edge of such latch 2 principally performs such spring clamp function.

Thus, Applicants respectfully submit that the McCrorey plate 6 does not include all the features of the clip recited in claims 1 and 11 of the present application. Likewise, Applicants respectfully submit that the McCrorey reference cannot be applied to make obvious such a clip for the reason that the McCrorey reference wholly fails to appreciate that any particular element should or could both be fixedly attached to a body and also have a gripping section with a distal end that extends to the plane of the brim surface of the body for gripping a flange along with a gripping surface of the body, all as is required by claims 1 and 11.

Thus, for all of the aforementioned reasons, Applicants respectfully submit that the McCrorey reference cannot be applied to anticipate or even make obvious claims 1 and 11 and any claims depending therefrom. Accordingly, Applicants respectfully request reconsideration and withdrawal of the section 102(b) McCrorey rejection.

The Examiner has rejected claims 1, 3, 4, 11, 13, and 14 under 35 USC § 102(b) as being anticipated by Hume (U.S. Patent No. 2,036,757). Applicants respectfully traverse the section 102(b) Hume rejection.

To again summarize, the present invention includes:

- a planar attaching section of a clip, a generally planar attaching surface of a body, and a generally planar brim surface of a body that are all substantially parallel, and
- a gripping section of a clip that has a distal edge that resides in a plane generally coextensive with the generally planar brim surface of the body

among other distinctive features.

The Hume reference discloses a wheel-balancing weight with a body 11 and a clip 10, as is best seen in Fig. 5 thereof. In particular, the Hume clip 10 is formed from as a single piece of material to include a gripping section 12 and an attaching section fixedly attached to the body 11 by way of a stud 13. However, and significantly, the Hume body 11 has a brim surface that is markedly out of parallel with respect to the attaching section of the clip 10 (i.e., in the area of stud 13 thereof) and the corresponding attaching surface of the body 11. In particular, and as best seen in a combination of Figs. 1 and 5, the Hume brim surface is opposite a brim section of a flange, where such brim section is almost perpendicular to the attaching section of the clip 10 and the corresponding attaching surface of the body 11.

Moreover, and as also seen in the Hume reference at Figs. 1 and 5 thereof, the gripping surface of the Hume body, which is opposite the gripping portion of the Hume clip and adjacent the distal edge thereof, is almost parallel with the attaching surface of such body, and therefore most definitely does not extend generally perpendicularly from such attaching surface as is required by claims 1 and 11.

Thus, Applicants respectfully submit that the Hume reference does not disclose all the features of the weight recited in claims 1 and 11 of the present application.

Likewise, Applicants respectfully submit that the Hume reference cannot be applied to make obvious such a clip for the reason that the Hume reference like the McCrorey reference wholly fails to appreciate that any particular element should or could both be fixedly attached to a body and also have a gripping section with a distal end that extends to the plane of the brim surface of the body for gripping a flange along with a gripping surface of the body, all as is required by claims 1 and 11.

Thus, for all of the aforementioned reasons, Applicants respectfully submit that the Hume reference cannot be applied to anticipate or even make obvious claims 1 and 11 and any claims depending therefrom, including claims 3, 4, 13, and 14. Accordingly, Applicants respectfully request reconsideration and withdrawal of the section 102(b) Hume rejection.

The Examiner has rejected claims 9 and 19 under 35 USC § 103(a) as being obvious over the Hume reference. Applicants respectfully traverse the section 103(a) Hume rejection.

Applicants respectfully submit that since claims 1 and 11 have been shown to be unanticipated and are non-obvious, then so too must all claims depending therefrom be unanticipated and non-obvious, at least by their dependency. Accordingly, Applicants respectfully request reconsideration and withdrawal of the section 103(a) Hume rejection.

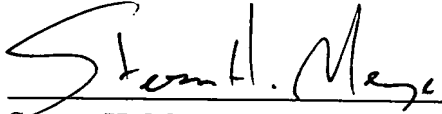
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**PATENT**

In view of the foregoing, Applicants respectfully submit that the present application including claims 1, 3, 4, 9, 11, 13, 14, and 19 is in condition for allowance, and such action is respectfully requested.

Respectfully submitted,

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